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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,587	10/23/2001	Seiya Motomiya	6667/24 (LTC-16-US)	6477

7590 11/30/2004  
BRINKS HOFER GILSON & LIONE  
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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/037,587

Applicant(s)

MOTOMIYA, SEIYA

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6,8,10-13,15-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,8,10-13,15-18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/037,587.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Repeated Rejections***

1. The 35 U.S.C. 103 rejection of claims 6, 8, 12, 13, 17, 18, 22 and 25 over Gosselin et al. in view of Smith, Yuyama et al., JP 55-155079 and Yoshikawa et al. is repeated for reasons previous of record in the paper dated May 28, 2004.

The limitation “formed by using a thermal transfer printer or thermal transfer printing apparatus” is a process limitation. The determination of patentability for a product claim with a process limitation is based on the product itself and not on the method of production. In this case, the limitation of the printed layer being formed using a thermal transfer printer or thermal transfer printing apparatus is a method of production and therefore does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

However, if even the limitation of the method of production is germane to the patentability, Gosselin et al. disclose that the method of using thermal transfer printers to form the thermal transfer printed layers with a pigment or dye as part of the pressure sensitive adhesive label (Column 6, lines 40 – 42 and 59 – 61) is well known in the art.

Art Unit: 1772

2. The 35 U.S.C. 103 rejection of claims 10, 11, 15, 16, 20, 21, 23 and 24 over Gosselin et al. in view of Smith, Yuyama et al., JP 55-155079 and Yoshikawa et al. and further in view of Takizawa et al. is repeated for reasons previous of record in the paper dated May 28, 2004.

The limitation “formed by using a thermal transfer printer or thermal transfer printing apparatus” is a process limitation. The determination of patentability for a product claim with a process limitation is based on the product itself and not on the method of production. In this case, the limitation of the printed layer being formed using a thermal transfer printer or thermal transfer printing apparatus is a method of production and therefore does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

However, if even the limitation of the method of production is germane to the patentability, Gosselin et al. disclose that the method of using thermal transfer printers to form the thermal transfer printed layers with a pigment or dye as part of the pressure sensitive adhesive label (Column 6, lines 40 – 42 and 59 – 61) is well known in the art.

### ***Response to Arguments***

3. Applicant's arguments filed in the paper dated August 30, 2004 with regard to the 35 U.S.C. 103 rejections of claims 6, 8, 10-13, 15-18 and 20-24 have been fully considered but they are not persuasive.

Art Unit: 1772

4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant individually argues that Smith, Yoshikawa and Yuyama fail to disclose a thermal transfer printed layer made with the use of a thermal transfer printer or thermal transfer printing apparatus; however, in combination with Gesslin et al., a security label with a release sheet, the transfer printed layer made with the printer or printing apparatus is taught (Column 6, lines 40 – 42 and 59 – 61).
5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As shown by the analogous art used in the above rejections, it would be within the level of one of ordinary skill in the art to combine the references since each piece of prior art presents a variation of the same product, a release sheet in combination with a pressure sensitive adhesive label, thereby making the combinations obvious. Therefore, even though Yuyama does not teach compatibility between the releasing agent and the thermal transfer printed layer and Yoshikawa does not teach the specific non-silicone based releasing

Art Unit: 1772

agent or that the pattern is formed of an epoxy resin, it would be obvious to one of ordinary skill in the art that the combination of the elements teaches the claimed invention.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

11/26/04